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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/666,146	09/18/2003	David L. Patton	84003AF-P	8215
7590 04/28/2004			EXAMINER	
Milton S. Sales Patent Legal Staff Eastman Kodak Company 343 State Street Rochester, NY 14650-2201			SPECTOR, DAVID N	
			ART UNIT	PAPER NUMBER
			2873	
DATE MAILED: 04/28/2004				

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No. 10/666,146	Applicant(s) PATTON ET AL.	
	Examiner David N. Spector	Art Unit 2873	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 18 September 2003 and 22 October 2003.
- 2a) ☐ This action is FINAL.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-13 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,2,6 and 13 is/are rejected.
- 7) ☒ Claim(s) 3-5 and 7-12 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 18 September 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>#1 (09/18/03)</u> . | 6) <input checked="" type="checkbox"/> Other: <u>DETAILED ACTION</u> .                  |

## DETAILED ACTION

### ***Claim Rejections - 35 USC § 102***

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. **Claim 1 is rejected under 35 U.S.C. 102(b) as being anticipated by Matsuura (US-6,246,530-B1).** Matsuura discloses a method of making a solid immersion lens device (**FIG. 9**, ref. **10'**) having a plurality of solid immersion lenses **20s**, comprising the steps of: providing said plurality of solid immersion lenses **20s** in a predetermined pattern (col. 8, ln. 30-32) and securing said solid immersion lenses **20s** in said predetermined pattern (*e.g. via supporting member S*) so as to cause them to be in a fixed position with respect to each other (col. 8, ln. 33-36). Claim 1 is therefore anticipated by Matsuura.

### ***Claim Rejections - Double Patenting***

3. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969). A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent

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is shown to be commonly owned with this application. See 37 CFR 1.130(b). Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

**4. Claims 2, 6, and 13 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 12 and 28 of U.S. Patent No. 6,683,723 B2 (hereinafter '723).** Although the conflicting claims are not identical, they are not patentably distinct from each other for the following reasons.

In regard to claim 2 Claim 12 of the '723 patent recites (*inter alia*) "A solid immersion lens device (e.g. array) comprising: a plurality of solid immersion lenses, and a body portion in which said plurality of solid lenses are integrally secured, said body portion having a surface designed to engage a sample for viewing of said sample through said plurality of solid immersion lenses". While the aforesaid claim 12 does not expressly recite "a top surface" (e.g. '*said body portion having a top [emphasis added] surface designed to engage a sample for viewing*'), it is clear from the context of the '723 claim that the 'surface' recited therein is the same as the 'top surface' recited in claim 2 of the instant application. Claim 2 of the instant application is therefore unpatentable over Claim 12 of the '723 patent.

In regard to claim 6 Claim 28 of the '723 patent recites (*inter alia*) " a cover slide having a plurality of solid immersion lenses integrally formed therein, said cover slide having a surface desired to engage a sample for viewing of said sample through said plurality of solid immersion lenses. Claim 6 of the instant application is therefore unpatentable over Claim 28 of the '723 patent.

In regard to claim 13 Claim 28 of the '723 patent recites (*inter alia*) "a cover slide having a plurality of solid immersion lenses integrally formed therein, said cover slide having a surface desired to engage a sample for viewing of said sample through said plurality of solid immersion lenses and an open viewing area designed to engage a sample

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for viewing of said sample using a microscope under normal magnification". Claim 13 of the instant application is therefore unpatentable over Claim 28 of the '723 patent.

***Other Remarks/Information***

5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to David N. Spector whose telephone number is (571) 272-2338. The examiner can normally be reached at this number Monday through Friday between 6:00 AM and 2:30 PM. In the event that attempts to contact the examiner by telephone are unsuccessful, the examiner's supervisor, Georgia Y. Epps can be reached at (571) 272-2328. The fax number for the organization where this application is assigned is (703) 872-9306.

April 26, 2004

A handwritten signature in black ink, appearing to read 'D. N. Spector', with a long horizontal stroke extending to the right.

**David N. Spector**  
**PRIMARY EXAMINER**